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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,350	05/25/2001	Martin Cullen	P-3925-1	2355

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EXAMINER

RACHUBA, MAURINA T

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 05/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/864,350

Applicant(s)

CULLEN, MARTIN

Examiner

M Rachuba

Art Unit

3723

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires ____ months from the mailing date of the final rejection.
b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
- they raise new issues that would require further consideration and/or search (see NOTE below);
 - they raise the issue of new matter (see Note below);
 - they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.
8. The proposed drawing correction filed on ____ is a) approved or b) disapproved by the Examiner.
9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. Other: See Continuation Sheet



M. Rachuba
Primary Examiner
Art Unit: 3723

Continuation of 2. NOTE: further limitations to the method of use of the claimed apparatus are new issues, requiring further consideration under 35 USC 112.

Continuation of 10. Other: Applicant argues that the method of use of the apparatus has been claimed. The examiner strongly disagrees. Claim 1 is directed to a tile saw. Claim 1 limits the apparatus. Claim 1 further limits how the apparatus is used. While "use" disagreements are considered when presented in apparatus claims, such limitations cannot be relied upon for patentability. Again, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). There is no structural difference between applicant's claimed structure and that of Sigetich et al. Sigetich et al discloses a ceramic tile shaping saw comprising a circular blade 33 having a peripheral cutting edge and a diameter of approximately 6 inches (which is "at least 6 inches" as claimed, note that Sigetich et al also disclose that a larger blade may be used, column 6, lines 52-55); motor means 31 connected to power the circular blade in rotation; a saw housing 29 having opposite ends, means at 27, 38 at one end for mounting the housing for pivotally traversing movement, means 35 at said opposite end for journaling the circular blade for rotation in extending depending relation therefrom; and a tile support 57 in positioning relation for supporting a tile, having an operative position location at an end of and in aligned relation to the path of the pivotal traversing movement of the housing. There is no difference between applicant's claimed structure, and that of Sigetich et al. If there is a difference, it may be in a method of cutting tile. Applicant has not directly, clearly and definitely claimed a method of cutting tile. Applicant has claimed an apparatus for cutting tile. The apparatus disclosed by Sigetich et al is fully capable of performing the function as claimed.